



APPENDIX A

PATENT CASE: CV01148K

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

-----X  
In re Application of:  
**Chackalamannil, et. al.**

For Patent:  
**XANTHINE PHOSPHODIESTERASE V  
INHIBITORS**

Serial No.:       **09/940,760**

Filed:            **08/28/2001**

U.S. Patent No. **6,821,978**

Issued:           **11/23/2004**  
-----X

Examiner: Sudhaker B. Patel

Group Art Unit: 1624

Schering-Plough Corporation  
Kenilworth, New Jersey 07033

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

REQUEST FOR A CERTIFICATE OF CORRECTION UNDER 37 CFR 1.323

Dear Sir:

Patentees respectfully request that a Certificate of Correction, pursuant to 35 USC § 255, and 37 C.F.R. 1.323, be issued to correct a mistake of minor character in the above-identified U.S. patent that was not the fault of the Patent and Trademark Office. In addition, patentees request correction of other mistakes which were incurred through the fault of the Office.

The mistakes are listed below. A Certificate of Correction (Form PTO/SB/44) listing the above-requested corrections is attached in duplicate. In addition, a Fee Transmittal (in duplicate) is submitted herewith, authorizing a charge as set forth in § 1.20(a) to our Deposit Account for this submission.

In re Application of: Chackalamannil, S. et al.

Serial No.: 09/940760

Filed: 08/28/2001

U.S. Patent No. 6,821,978

Issued: 11/23/2004

In accordance with §1485 of the MPEP, quotation marks (" ") are used to enclose the exact subject matter to be corrected, and double hyphens (-- --) are used to enclose subject matter to be added.

#### REMARKS

The corrections requested for Column 100, Claims 9 and 10 relate to an inadvertent error made in an amendment by Applicants in attempting to conform the claims to a particular invention for which Applicants had elected to continue with prosecution in the subject application. In the Election/Restriction Requirement mailed by the Office on February 5, 2003, Group I was defined as "Claims (in part) 1-21, 24-40, drawn to compounds, composition[s], a method of use and the first recited method of [making] the compounds of generic Formula (I) of claim 1 wherein  $R^4$  = *carbocycle which is non-aryl and non-heterocycle....*" (emphasis added). In the response dated May 5, 2003, Applicants elected to prosecute Group I, and amended Claims 1, 9, 13, 27 and 40 to delete recitations and structures reflecting  $R^4$  as a heterocycle, in accordance with this election. However, in preparing this Amendment, Applicants missed the fact that Claims 10 and 11 recited definitions of  $R^4$  that were beyond the scope of the elected invention. Thus, the failure to delete the recitation of tetrahydropyranyl groups from Claims 10 and 11 was an inadvertent error, and a mistake which occurred in good faith. Moreover, since these groups are outside the scope of Claim 9, from which they depend, the mistake is of minor character.

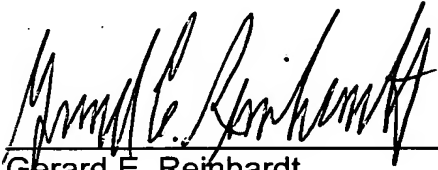
The other mistakes are typographic errors which were incurred through the fault of the Office.

Should any fees other than those indicated on the Fee Transmittal become necessary for the grant of this Certificate, the Commissioner is hereby authorized to charge any such fees to Deposit Account 19-0365.

In re Application of: Chackalamannil, S. et al.  
Serial No.: 09/940760  
Filed: 08/28/2001  
U.S. Patent No. 6,821,978  
Issued: 11/23/2004

Favorable action on this request is earnestly solicited.

Respectfully submitted,



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Gerard E. Reinhardt  
Reg. No. 43,041  
Attorney for Applicants  
(908) 298-2960

Dated: January 19, 2006

Docket Number: CV01148  
Application No: 09/940760  
Filing Date: 08/28/2001  
Express Mail Label:

Approved for use through 04/30/2007. OMB 0651-0033  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE  
(Also Form PTO-1050)

## UNITED STATES PATENT AND TRADEMARK OFFICE CERTIFICATE OF CORRECTION

PATENT NO. : 6821978  
DATED : 11/23/2004  
INVENTOR(S) : CHACKALAMANNIL, Samuel

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

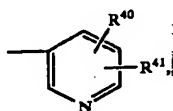
On the face of the patent, at item (74) Attorney, Agent or Firm, please replace "Gerald E. Reinhardt" with -- Gerard E. Reinhardt--.

In Column 97, Claim 1, line 18, please replace "-(R23)(R24)N(H)-" with -- -C(R23)(R24)N(H)- --.

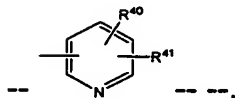
In Column 97, Claim 1, line 62, please delete "with or without".

In Column 98, Claim 1, line 8, please replace "-SO2R50" with -- -SOO-2R50 --.

In Column 98, Claim 1, line 25, please replace



with



MAILING ADDRESS OF SENDER:

**Gerard E. Reinhardt**  
Schering-Plough Corporation, Patent Dept, K-6-1, 1990  
2000 Galloping Hill Road, Kenilworth NJ 07033-0530

PATENT NO. 6821978

No. of additional copies

1 of 3

This collection of information is required by 37 CFR 1.322, 1.323, and 1.324. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Attention Certificate of Corrections Branch, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Docket Number: CV01148  
Application No: 09/940760  
Filing Date: 08/28/2001  
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## UNITED STATES PATENT AND TRADEMARK OFFICE CERTIFICATE OF CORRECTION

PATENT NO. : 6821978  
DATED : 11/23/2004  
INVENTOR(S) : CHACKALAMANNIL, Samuel

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

In Column 100, Claim 10, line 3, please delete "or pharmaceutical composition".

In Column 100, Claim 10, lines 4-5, please replace "R4 is a cyclohexyl, hydroxy-cyclopentyl or tetrahydropyranyl group" with -- R4 is a cyclohexyl or hydroxy-cyclopentyl group--.

In Column 100, Claim 11, line 7, please delete "or pharmaceutical composition".

In Column 100, Claim 11, lines 12-13, please replace "R4 is a cyclohexyl, tetrahydropyranyl group or 2(R)-hydroxy-1(R)-cyclopentyl group" with -- R4 is a cyclohexyl or 2(R)-hydroxy-1(R)-cyclopentyl group --.

In Column 103, Claim 22, line 57, please replace "R1-4" with -- R14 --.

In Column 104, Claim 26, lines 48-49, please delete "with or without".

In Column 104, Claim 26, line 50, please replace "C3-5 " with -- C3-15 --.

In Column 104, Claim 26, line 60, please delete "with or without".

In Column 106, Claim 26, line 3, please replace "a -CH2)q group" with a -(CH 2)q group--.


### MAILING ADDRESS OF SENDER:

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2000 Galloping Hill Road, Kenilworth NJ 07033-0530

PATENT NO. 6821978

No. of additional copies

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Docket Number: CV01148  
Application No: 09/940760  
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PTO/SB/44 (04-04)  
Approved for use through 04/30/2007. OMB 0651-0033  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE  
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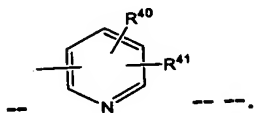
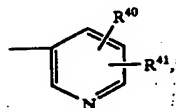
## UNITED STATES PATENT AND TRADEMARK OFFICE CERTIFICATE OF CORRECTION

PATENT NO. : 6821978  
DATED : 11/23/2004  
INVENTOR(S) : CHACKALAMANNIL, Samuel

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

In Column 106, Claim 26, line 61, please delete "with or without".

In Column 107, Claim 26, line 40, please replace  
" with



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